

App. No. 09/874,481

Amendment under 37 CFR §1.111

**REMARKS**

Claims 1-44 are pending in the instant application. Claims 1, 9, 11, 12, 19, 23, 31, 33, 34, and 41 are independent claims. Claims 23-44 drawn to an elected invention are under consideration. Claims 1-22 drawn to a non-elected invention are currently withdrawn from consideration. Claims 1, 3, 5, 7-19, 21-23, 25, 27, 29-41, 43, and 44 have been amended.

***Restriction/Election***

In the requirement for restriction dated 09/30/2004, Examiner had restricted the claims of the instant application into two groups:

- Group I (Claims 1-22) drawn to a data processing system performing an automated financial or business method, practice, or task; and
- Group II (Claims 23-44) drawn to a method of data processing comprising generating data base or database structure (e.g. via user interface).

In an election submitted 10/18/2004, Applicant elected Group II (Claims 23-44) drawn to the method for further prosecution, with traverse. Examiner had asserted that the inventions are distinct because "the process as claimed can be practiced by another, materially different apparatus, or by hand, such as by hand." Applicant argued in the traversal of the requirement that the steps recited in Claims 23-44 explicitly recite "under control of the programmed processor, the processor being programmed therefor", and that the method *as claimed* could not be performed by hand.

In the Action dated 02/11/2004, Examiner maintained and made final the restriction requirement, based on the assertion that a person could be the "programmed processor", and that the claimed method could therefore be performed by hand. Applicant never intended the phrase "programmed processor" to encompass a person, but to encompass a computer processor or other electronic processor. Accordingly, the claims have been amended to recite a "programmed computer processor" throughout. In light of this amendment, Applicant repeats his earlier assertion that the claimed method could not be performed by hand, and respectfully requests withdrawal of the restriction requirement and rejoinder of withdrawn claims 1-22.

***Claim Rejections under 35 USC §101***

Examiner has rejected Claims 23-44 under 35 USC §101 as directed to non-statutory subject matter. Examiner has asserted that Claims 23-44 are drawn to a

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method of producing a disembodied data structure, and that the claims fail to require the use of any technology.

Applicant respectfully submits that Claims 23-44, as amended, are directed to statutory subject matter. As already noted hereinabove, Claims 23-44 have been amended to recite a "programmed *computer* processor" throughout, thereby tying the claims to a technological art as required.

Applicant further respectfully submits that Claims 23-44 do not recite a method merely for producing a disembodied data structure. While Claims 23-44 do include steps for reading from, writing to, or manipulating a data structure (i.e., a database), they also include other steps leading to useful, concrete, and tangible results. Each of the independent claims recites "transmitting instructions for delivery ... of each ordered and located product ..., thereby causing fulfillment of the order." This is not merely a manipulation of a disembodied data structure, but is instead "a useful, concrete and tangible result". Instructions, either electronic or printed, are transmitted directing action on a physical object (i.e. delivery of an ordered product). Each of the independent claims also recites "creating and transmitting a financial accounting record for each delivered product". Again, this is not merely a manipulation of a disembodied data structure, but the generation of "a useful, concrete and tangible result". *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).

Applicant respectfully submits that rejection of Claims 23-44, as amended, under 35 USC §101 is improper. Applicant respectfully requests withdrawal of the rejection.

#### ***Claim Rejections under 35 USC §103***

Examiner has rejected Claims 23-44 under 35 USC §103 as being unpatentable over Sharp (US6263317).

Applicant respectfully submits that Claims 23-44, as amended, patentably distinguish over Sharp, for the reasons set forth hereinbelow.

In rejecting Claims 25-30, Examiner has stated that

Sharp et al fail to disclose that "the purchaser has any particular relationship to any other entity associated with the product (i.e., a retailer of the product purchasing the product from another retailer of the product). However, the method of Sharp et al does not preclude that one entity associated

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with the product could purchase the product from another entity associated with the product, and one of ordinary skill in the art would recognize that such a step could be performed using the method of Sharp et al.

First, the relationships recited in the claims are not between the purchaser and another entity, but between the entity receiving an order from the purchaser and the entity fulfilling the order (i.e. delivering ordered items to the purchaser). The methods recited in the claims are not methods for one entity to purchase from another, but are methods for one entity to receive an order from a purchaser and for another entity to fulfill the order.

Claims 23, 26, 28, and 31, as amended, each recite a method in which orders are received and fulfilled utilizing "horizontal" interactions between entities (as defined in the background section of the specification; e.g. retailer-to-retailer or distributor-to-distributor). It is precisely these "horizontal" interactions that Applicant respectfully submits are patentably novel. Sharp discloses methods in which one entity fulfills an order received by another entity, but only utilizing "vertical" interactions as defined in the specification. Nowhere does Sharp disclose horizontal interactions between independent retailers or between independent distributors, nor does Sharp contain any suggestion or motivation to do so.

Furthermore, the fact that "the method of Sharp et al does not preclude that one entity ... could purchase the product from another entity ..." is not a sufficient basis for an obviousness rejection unless the prior art also suggests the desirability of the claimed method. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Such a suggestion of desirability has not been demonstrated in the Office Action. Applicant respectfully submits that traditional competition between independent retailers or between independent distributors would typically preclude, or at least discourage, the types of "horizontal" interactions recited in the claims. A person of ordinary skill in the art would not be motivated to modify the methods disclosed by Sharp to include such non-traditional "horizontal" interactions, absent the teachings of the Applicant's specification.

In light of the foregoing, Applicant respectfully submits that rejection of Claims 23-32, as amended, under 35 USC §103 is improper. Applicant respectfully requests withdrawal of the rejection.

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Regarding Claim 33, Examiner has not provided any specific explanation for the rejection of this claim. Applicant respectfully submits that none of the steps of i) enabling a fulfilling provider conceal its identity from an order-receiving provider, ii) enabling an order-receiving provider to conceal its identity from a fulfilling provider, or iii) enabling an order-receiving provider to conceal the identity of a purchaser from a fulfilling provider, are disclosed by Sharp, nor does Sharp provide any teaching, suggestion, or motivation for doing so, nor has any such teaching, motivation, or suggestion been demonstrated elsewhere in the prior art. Applicant respectfully submits that rejection of Claim 33, as amended, under 35 USC §103 is improper. Applicant respectfully requests withdrawal of the rejection.

Regarding Claims 34-40, Examiner has asserted that "aggregating orders is a well known, hence obvious, step to perform in any method of electronic ordering". However, "automatically aggregating *in real time*", as recited in amended Claim 34, is not taught, suggested, or motivated by Sharp, nor has any teaching, suggestion, or motivation been demonstrated in the prior art. Aggregation of orders placed with multiple independent product suppliers (Claims 38-40), and aggregation of onsite and online orders (Claim 36), are new and useful results achieved by the claimed methods that are not shown, taught, suggested, or motivated by Sharp, nor has any such teaching, suggestion, or motivation been demonstrated elsewhere in the prior art. Such new and useful results are patentable. *In re Wright*, 122 USPQ 522. Applicant respectfully submits that rejection of Claims 34-40, as amended, under 35 USC §103 is improper. Applicant respectfully requests withdrawal of the rejection.

Regarding Claim 41-44, Applicant respectfully submits that none of the steps of i) monitoring local inventory information in real time, ii) transmitting instructions for transferring inventory among product retailers, and iii) updating local inventory information, are disclosed by Sharp, nor does Sharp provide any teaching, suggestion, or motivation for doing so, nor has any such teaching, suggestion, or motivation been demonstrated elsewhere in the prior art. As described hereinabove, such retailer-to-retailer interactions would typically be discouraged or precluded. Applicant respectfully submits that rejection of Claims 41-44, as amended, under 35 USC §103 is improper. Applicant respectfully requests withdrawal of the rejection.

At several points in the Office Action the Examiner has asserted (without citing any specific reference) that various steps not disclosed by Sharp are nevertheless well known, and that incorporation of such steps into the method of Sharp would constitute an obvious modification of the method of Sharp. If the Examiner maintains any rejection

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based in part on such an assertion, or makes any new rejection based in part on a similar new assertion, Applicant respectfully requests that the Examiner provide an affidavit in support thereof as set forth in 37 CFR §104(d)(2).

**Conclusion**

In view of the above, it is respectfully submitted that Claims 23-44, as amended herein, are in condition for allowance. Applicant respectfully requests withdrawal of the restriction requirement and rejoinder of Claims 1-22, which are also believed to be, as amended herein, in condition for allowance. Allowance of Claims 23-44, and rejoinder and allowance of Claims 1-22, at an early date is earnestly solicited.

Respectfully submitted,

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